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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,199	10/16/2000	Billy P. Taylor	28150.7	2251

27683 7590 01/13/2005

HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER
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EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/690,199

Applicant(s)

TAYLOR, BILLY P.

Examiner

Hussein A El-chanti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to RCE received on Oct. 12, 2004. Claims 1-21 were amended. Claims 1-21 are pending examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Perkowski, U.S. Patent No. 6,625,581.

As to claim 1, Perkowski teaches a method performed by a computer system comprising:

storing a digital version of a mass-produced printed paper, wherein the digital version is displayable on a display device as a likeness of the paper (see col. 18 lines 50-67); and

forming a hyperlink reference within the digital version, wherein the hyperlink reference is associated with an operation of the computer device and with a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 19 lines 1-38).

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As to claim 8, Perkowski teaches a system comprising:

storing a version of a mass-produced printed paper (see col. 18 lines 50-67); and

forming a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 19 lines 1-38)

As to claim 15, Perkowski teaches a computer program product comprising a computer program processable by a computer system for causing the computer system to:

store a version of a mass-produced printed paper (see col. 18 lines 50-67); and

form a reference within the version, wherein the reference is a hyperlink associated with an operation and at least a portion of the version, wherein the version is displayable on a display device as a likeness of the paper and wherein the portion is selectable to cause performance of the operation (see col. 19 lines 1-38)and

an apparatus from which the computer program is accessible by the computer system (see col. 19 lines 1-38)

As to claims 2, 9 and 16, Perkowski teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

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forming the reference within the version wherein the portion is displayable on the display device as a likeness of an advertisement within the paper (see col. 17-col. 18).

As to claims 3, 10 and 17, Perkowski teaches the method, system and program of claims 2, 9 and 16 respectively wherein the forming comprises:

forming the reference within the version wherein the hyperlink specifies a website associated with the advertisement (see col. 17-col. 18).

As to claims 4, 11 and 18, Perkowski teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the hyperlink specifies a website and wherein the operation includes displaying the website (see col. 17-col. 18).

As to claims 5, 12 and 19, Perkowski teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes displaying a visual image in response to the file (see col. 17-col. 18).

As to claims 6, 13 and 20, Perkowski teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the reference specifies a file and wherein the operation includes outputting audio signals in response to the file (see col. 17-col. 18).

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As to claims 7, 14 and 21, Perkowski teaches the method, system and program of claims 1, 8 and 15 respectively wherein the forming comprises:

forming the reference within the version wherein the reference specifies a script and wherein the operation includes executing the script (see col. 17-col. 18 and fig. 4M1-4T1).

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Method, system and computer program product for producing and distributing enhanced media downstreams by Holtz et al., U.S. Patent No. 6,760,916
- Automated interactive classified ad system for the internet by Witek et al., U.S. Patent No. 6,253,188

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein Elchanti

Dec. 17, 2004



ARTO ETIENNE  
SUPERVISORY PATENT EXAMINER  
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